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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,015	04/09/2001	Salim G. Kara	061135/P000C2CP1C1/101032	9558
29053	7590	06/16/2005		
DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P. 2200 ROSS AVENUE SUITE 2800 DALLAS, TX 75201-2784				
EXAMINER COSIMANO, EDWARD R				
ART UNIT		PAPER NUMBER		
3639				

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/829,015

**Applicant(s)**

KARA, SALIM G.

**Examiner**

Edward R. Cosimano

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
4a) Of the above claim(s) none is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-16 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 09 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

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1. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 120 is acknowledged.

2. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

3. Claims 1-16 are rejected under the judicially created doctrine of double patenting over claims 1-47 of U. S. Patent No. 6,233,568 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

3.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A) determining transaction parameters;

B) using the determined parameters to rate an item to be shipped by a carrier for a plurality of carriers;

C) providing the rating results for comparison; and

D) based on the comparison picking a carrier.

3.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

3.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

3.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

4.1 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

A) the prior art, for example:

(1) either Piccione (4,495,581) or Barns-Slavin et al (5,117,364) or Thiel (EP 0805422 or 5,699,258 or 6,035,291 or 6,321,214), which disclose determining the lowest cost carrier for an item to be shipped based on user entered shipping transaction parameters.

(2) Berson et al (6,039,257), which discloses using accounting information to generate a multidimensional barcode for the validation of a postage indicia.

B) however, in regard to claims 1, 9, the prior art does not each or suggest a machine/process for authorizing a transaction for an item by selected provider that is implemented on a system that executes programs for other functions, where the value of the transaction is determined for a number of providers based on entered transaction parameters and then displayed so that a provider may be selected and an authorization

indicia may be obtained and printed. Claims 2-7, 10-12, 15 & 16 are allowable for the same reason.

C) however, in regard to claims 8, 13 & 14, the prior art does not each or suggest a machine/process for authorizing a transaction for an item by selected provider that is implemented on a system that receives transaction parameters from other programs unrelated to the transaction, where the value of the transaction is determined for a number of providers based on entered transaction parameters and then displayed so that a provider may be selected and an authorization indicia may be obtained and printed.

6. Response to applicant's arguments.

6.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

6.2 As per the double patenting rejection, even though both instant applicant and the U.S. Patent 6,233,568 will expire on the same date, since:

A) both the claims of the instant applicant and the claims of U.S. Patent 6,233,568 will cover the same overlapping subject matter that forms the hart of the claimed invention as set forth above in the rejection regardless of any recitation of a new intended use or new additional limitations that are directed to additional subject matter or functions; and

B) it is conceivable that during enforceable life of either patent the patens may be separately assigned to different owners;

a Terminal Disclaimed to tie the patents together must be required so that both patents will remain under common ownership. Hence, applicant's argument's are non persuasive.

7. The examiner has cited prior art of interest, for example:

A) Sheng-Jung (4,940,887) discloses a mail processing system in which an item of mail is accepted into the system, the required amount of postage is determined based on a measurement of the weight of the item and the weight and postage is displayed. If the user pays the displayed postage, then the item is marked with an postage indicia and stored with in the system until the item of mail is collected by the carrier.

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B) Whitehouse (6,005,945) discloses a PC base metering system in which a common PC runs postage related software to request a postage indicia from a remote computer system so that the requested postage indicia may be printed on an item of mail.

C) Fruechtel (6,175,825) discloses user entered data being used to determine the required postage for an item to be shipped by a selected carrier.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (571) 272-6802. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (571) 272-6812. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-3600.

8.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (571) 273-6802.

8.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

8.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

05/25/05

  
Edward R. Cosimano  
Primary Examiner A.U. 3639